

REMARKS

Claims 1-5, 8-14, 17-23, 26-27 are pending. In the Office Action mailed December 23, 2003, the Examiner rejected claims 1-5, 8-14, 17-23 and 26-27 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,991,751 ("Rivette") in view of DIALOG Patent Seminar ("Yamonaco"). Applicants respectfully traverse the rejection and request reconsideration.

Applicants' invention relates generally to a system for identifying assignees that are potential licensees of patents that are associated with a particular set of patents (i.e., patents in a source patent portfolio) that are of interest to a user. A set of associated patents includes patents that cite as a reference a patent in the source patent portfolio or are cited as a reference by a patent in the source portfolio. The set of associated patents is processed to establish a set of assignees contained in the set of associated patents.

A set of remaining assignees is then established by removing from the set of assignees all the assignees that are currently licensed. The set of remaining assignees is organized according to a ranking criteria that causes a higher ranking to be given to any assignee when the following ratio is greater for that assignee than for other assignees — assignee's patents in the set of associated patents / all patents held by assignee. That is, the set of remaining assignees is organized according to a specific ratio.

In the Office Action, the Examiner states that "Rivette does not explicitly disclose organizing the set of remaining assignees according to a ranking criteria that causes a higher ranking to be given any assignee when the following ratio is greater for than for other assignees." The Examiner then turns to Yamonaco to find this element. However, Yamonaco does not teach or suggest ranking patents according to any ratio, let alone the particular ratio claimed by Applicants.

Yamonaco teaches ranking a set of patents according to the number of patents in that set that are assigned to a particular assignee. As shown on Page 8-6, Yamonaco displays a "RANK No." column that has numbers 1-8 for ranking eight different assignees. The adjacent "No. Items Ranked" column makes clear that the assignees are being ranked based solely on the number of patents that assignee has in the particular set of patents. BAXTER INTERNATIONAL, INC. is ranked number one, since it has four patents in the set, which is the most number of patents any assignee has in the set. I-FLOW CORPORATION is ranked number two, since it has three patents in the set, which is less than BAXTER but more than any of the other assignees.

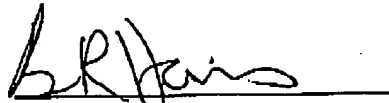
Contrary to the Examiner's assertions, Yamonaco simply does not teach or suggest ranking assignees according any ratio, and therefore certainly does not teach or suggest ranking assignees according to the specific ratio claimed in Applicants' independent claims. Moreover, Yamonaco does not teach or suggest any reason for making such a modification. Thus, any suggestion that one skilled in the art would have made such a modification even though ranking according to ratios is not taught or suggested in any of the references would simply be impermissibly using the hindsight afforded by Applicants' own disclosure.

Each of Applicants' independent claims 1, 10 and 19 includes the element of ranking patents according to a particular ratio, which is neither taught nor suggested by either of the two references cited by the Examiner. Therefore, independent claims 1, 10 and 19 are in condition for allowance. Accordingly, dependent claims 2-5, 8-9, 11-14, 17-18, 20-23 and 26-27 are also in condition for allowance.

Applicants submit that this is in condition for allowance and request notice to that effect. Should the Examiner feel that further dialog would advance this application to issuance, he is invited to telephone Applicants' attorney, Brian Harris, at his direct dial number of (312) 913-3303.

Respectfully submitted,

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